

**REMARKS**

Claims 1-39 are pending in this application. Claims 1-18, 30, and 35-38 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,032,257 (Olarig). Claims 1-20, 24-26, 30, 31, 35, 36, 38, and 39 have been rejected under section 102(b) as being anticipated by U.S. Patent No. 5,778,421 (Nagano). Claims 21-23, 27-29, 32-34, and 37 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over Nagano. Claim 34 has been objected to.

Applicant has amended claim 34 in response to the objection. The amendment to claim 34 addresses only a minor typographical oversight in claim 34, is not made for any reason related to patentability, and does not affect the scope of claim 34. Since no change has been made to the scope of claim 34, the amendment should not necessitate either a further search of claim 34 or any new grounds for rejection. Thus, applicant notes that – should the Examiner reject any of the claims on different grounds in the next Office Action – the new grounds of rejection would be unrelated to the amendment to claim 34, and thus such a rejection should be made non-final.

For the reasons set forth below, applicant respectfully disagrees with, and traverses, the section 102 and 103 grounds for rejection.

The references relied upon – Olarig and Nagano – are generally directed to the problem of authenticating a device before allowing that device to perform some action. Despite this surface similarity with the references cited, the claimed invention recites various features that are not taught or suggested in the prior art. Below, applicant has highlighted features that are not taught in the applied prior art.

Additionally, it should be noted that the stated grounds for rejecting various claims have omitted any discussion of the features recited in those claims, or citation of the portions of prior art that are asserted to teach those claims. As to those rejections as to which no detailed reason has been given, applicant has not had a meaningful opportunity to understand, and respond to, the basis for the rejection. Thus, applicant has highlighted certain portions that – if the Examiner determines to maintain the rejection in a subsequent Office Action on newly-stated grounds – would justify making the subsequent Office Action non-final so that

applicant can have an opportunity to respond to grounds for rejection that are not stated in the present Office Action.

Claims 1-18, 20, 25, 26, 30, 31, 35, 36, and 38

Before turning to a list of the features that differ from the applied prior art, applicant would like to address an issue with respect to the substance of the rejection of claims 1-18, 20, 25, 26, 30, 31, 35, 36, and 38. In paragraphs 13 and 14 of the Office Action, these claims have been rejected under section 102(b) as being anticipated by Nagano. These paragraphs rejects claims 1-18, 20, 25, 26, 30, 31, 35, 36, and 38 with barely any citation to Nagano. There are no column/line citations to the text of Nagano, and there is only scant reference to specific elements of the figures. In substance, all of claims 1-18 have been rejected based on Nagano's alleged teaching of "allowing the manufacture of device 40", and claims 20, 25, 26, 30, 31, 35, 36, and 38 have been rejected based on the assertion that "the interface requires the contacters 26, 47 and won't record to the device without proper authentication." The Examiner has not cited any portion of Nagano to support the assertion about what the interface allegedly "won't record to the device," or about the "allowing" of the manufacture of device 40. Moreover, in the seven (7) lines that make up paragraphs 13 and 14 of the Office Action, the Examiner has rejected 26 different claims (including four independent claims), with barely a mention of any feature that is actually recited in those claims. Applicant is at a loss to respond to these grounds for rejection, other than to say that "device 40" and "contacters 26, 47" do not teach or suggests the full panoply of features that is recited in the 26 claims mentioned above. As noted in MPEP 707.07(d), an "omnibus" rejection, or one that groups a plurality of claims together, is not the favored practice. Moreover, prior to final action, a "clear issue" should develop between the applicant and the examiner. MPEP 706.07. The Office Action does not explain, in any meaningful way, how Nagano is being applied to claims 1-18, 20, 25, 26, 30, 31, 35, 36, and 38, so applicant has been deprived of a clear issue to which he can respond.

Thus, applicant requests that the Examiner either withdraw the rejection of these claims over Nagano, or explain how the Examiner proposes to apply Nagano to these claims, in a non-final Office Action so that applicant can have an opportunity to respond to any new grounds for rejection.

**Claim 1**

Claim 1 recites “determining that a portable memory recording device is trustworthy based on a hardware interface between said data processing device and said portable memory recording device.” The Examiner (in addition to the Nagano rejection, addressed above), has cited Olarig’s teachings to the effect that a peripheral device may contain an authentication code which is used in a handshake operation before the peripheral may be used with another device. Olarig’s focus is on theft-prevention, not trust, so it is unclear that Olarig’s authentication code and handshake determines “trustworthiness” as called for in claim 1. However, even if one assumes that Olarig’s authentication code/handshake could be used to determine trustworthiness, this determination is not made “based on a hardware interface,” but rather is made based on the presence of the correct number – i.e., the authentication code – in the peripheral device. The “based on a hardware interface” claim feature does not read on the cited teaching.

Although the Examiner has not specifically explained how the “based on a hardware interface” feature is being applied, it should be noted that “based on a hardware interface” does not mean merely that a number is passed from one piece of hardware to another. As set forth in the present application, one device can be configured to trust only devices that have certain types of interfaces. (See p. 19, lines 19-20.) Although the claims are limited only by their language and not by the examples in the specification, it should be noted that “based on a hardware interface” is not the same as the features of Olarig that have been cited, since Olarig does not find trustworthiness “based on a hardware interface.”

Thus, applicant respectfully requests reconsideration of the rejection of claim 1.

**Claim 2**

Claim 2 calls for “determining that [a] portable memory recording device will not record said protected content onto portable memories falling outside of a class.” The Examiner asserts that Olarig teaches “not recording outside of a class, the class being memories that run on that authorized system.” Since the Examiner has not cited any particular portion of Olarig, it is impossible for applicant to evaluate the Examiner’s assertion as to what Olarig teaches. However, even assuming that Olarig teaches what the Examiner

asserts it teaches, this teaching is quite different from what is claimed. Determining that a device will not record outside of a class is not the same as failing to record outside of the class. For example, an incorrect determination about what the device will (or will not) do still falls within the meaning of the claim, even if it results in recording outside of the class. Thus, even Olarig's uncited, asserted teaching does not meet the features of claim 2, and applicant requests reconsideration of the rejection of claim 2 over Olarig.

#### Claims 3 and 12

Claim 3 calls for determining "with less than absolute certainty" that a device will not record on a memory outside of a class. The Examiner has merely cited Olarig's alleged teaching about "not recording outside of a class," but has not addressed the issue that the claimed determination is made with "less than absolute certainty." Claim 12 recites a similar feature. Applicant has not found this feature in any of the prior art cited. Applicant thus request reconsideration of the rejections of claims 3 and 12. Moreover, since the Office Action does not address the "less than absolute certainty" feature, if the Examiner continues to maintain the rejection of claims 3 and 12 and provides new reasons for the rejection, then applicant requests that such rejection be provided in the form of a non-final office action so that applicant can have a meaningful opportunity to respond to the rejection.

#### Claims 4 and 14

Claim 4 recites (in combination with its base claims) that a device is determined not to record onto portable memories that fall outside of a class, where "a characteristic of a class is that portable memories falling inside said class are not readable by portable memory reading devices lacking a defined feature." Claim 14 recites a similar feature. The Examiner has not discussed this claim feature, and has instead relied on the general assertion that Olarig teaches "not recording outside of a class." The Examiner has not discussed the "defined feature" limitation, and particularly has not discussed the feature that memories falling outside the class "are not readable by a portable memory reading device lacking a defined feature." Although the Examiner has not specifically discussed this claim feature, or explained what portions of Olarig are asserted to teach this claim feature, applicant notes that Olarig is directed generally to peripheral devices that authenticate themselves by

demonstrating possession of an approved code or number, which has nothing do with a “defined feature,” or whether a memory is readable by a device that lacks a defined feature.

Since the Examiner has not addressed this feature, and since the claimed feature is not found in the applied prior art, applicant requests reconsideration of the rejection of claims 4 and 14. If the Examiner determines to provide a new explanation of the grounds for rejection of claims 4 and 14, applicant requests that such explanation be provided in a non-final office action, so that applicant can have a meaningful opportunity to respond to such grounds for rejection, since no grounds for rejecting claims 4 and 14 have been provided in the present Office Action.

Claims 6-8, 15, 16, 26

Claims 6-8, 15, 16, and 26 recite a “proprietary feature.” In the rejection of these claims, the Examiner finds that the “proprietary” feature is found in Olarig, although without any citation to any particular portion of Olarig. The crux of the rejection, however, is that Olarig allegedly teaches “vendor-specific” features, and that “vendor-specific” is the same as proprietary. Moreover, the Examiner asserts that “[c]learly the recited permission is obtained for a manufacturer to make such a device.” There are numerous errors in this statement.

First, “vendor-specific” is not the same thing as “proprietary.” There are numerous examples of features that are “proprietary” but not vendor-specific (e.g., technologies that are licensed to numerous vendors/manufacturers are “proprietary” but not “vendor-specific”). Conversely, there are features that are “vendor-specific” but not “proprietary” (e.g., there may be features that are used in one vendor’s product and are not protected under any concept of the word “proprietary,” but that no other vendor has deemed to be worthy of emulation; such features would be “vendor-specific” without being “proprietary”). Second, there is no “recited permission,” since “permission” is a term that does not appear in the claim. Third, inasmuch as the Examiner’s view that Olarig teaches “proprietary” features is based on the notion that it must be assumed that the manufacturer has obtained “permission,” this assertion is simply not true. Even proprietary features can be used without obtaining anyone’s permission; the asserted owner may have recourse against the one who uses the feature, but it is not the case that “permission” implies “proprietary”, or vice versa. In fact, the application explains (see page 17, lines 15-25) that the possibility of trusting a counterfeit

(but proprietary) device is an acceptable risk, as long as there is sufficient disincentive to create a counterfeit device.

Finally, it should be noted that none of the Examiner's reasoning is supported by citation to Olarig, so, even if one could accept the logic described above, the Examiner has not demonstrated that the features in the above-mentioned claims are found in Olarig.

Accordingly, applicant respectfully requests reconsideration of the rejection of claims 6-8, 15, 16, and 26. Since the Examiner has not provided any support for the proposition that Olarig teaches the features of these claims, if the Examiner should decide to maintain the rejection by providing a new explanation, it is requested that the Examiner do so in a non-final Office Action so that applicant may have a meaningful opportunity to respond to such new grounds of rejection.

#### Claim 8

Claim 8 recites that a hardware interface comprises a proprietary feature. Claim 8 has been rejected over Olarig. The Examiner has not discussed the "hardware interface" feature. Applicant respectfully submits that Olarig does not discuss features relating to a "hardware interface." (It should be noted that not all "hardware" is a "hardware *interface*"; thus, the Examiner's reference to "vendor-specific hardware" do not address the "hardware interface" feature.) Moreover, for the reasons discussed above, Olarig does not discuss the proprietary nature of such a feature.

For these reasons, applicant respectfully requests reconsideration of the rejection of claim 8. Additionally, since the features recited in claim 8 have not been specifically discussed, if the Examiner determines to maintain the rejection of claim 8 by providing a new explanation, it is requested that such rejection be provided in the form of a non-final Office Action so that applicant can have a meaningful opportunity to respond to such new ground for rejection.

#### Claim 9

Claim 9 calls for "determining that the recording of said protected content onto said portable memory is permitted by the terms of a license governing said protected content." In response to this claim, the Examiner has asserted (without any citation to a portion of Olarig)

that Olarig discloses “limited copying” – or, rather, that “limited copying” is inherent in Olarig’s “authentication requirement,” and that claim 9 reads on this alleged “inherent” feature of Olarig. Since the Examiner has not disclosed what portion of Olarig is alleged to teach this feature (or what portion demonstrates the inherency of this feature) it is difficult for applicant to address how Olarig is being applied. However, it should be noted that “limited copying” is not the same as a license that permits recording of protected content. At a minimum, a such a license might implement a form of limited copying, but this does not mean that Olarig’s alleged inherent teaching of “limited copying” in general teaches the specific licensing structure recited in the claims. Moreover, “limited copying” is not, as a general proposition, inherent in “authentication” (i.e., authentication may be used for various reasons, of which limited copying is only one example). Thus, if the Examiner’s position is that “limited copying” is inherent in Olarig’s alleged teaching of “authentication,” and that “limited copying” is the same as the license structure recited, then this argument is simply wrong.

For these reasons, applicant requests reconsideration of the rejection of claim 9. Moreover, since the Office Action does not even mention the license feature, if the Examiner determines to maintain the rejection of claim nine based on a new explanation, then applicant respectfully requests that such new explanation be provided in the form of a non-final Office Action so that applicant may have a meaningful opportunity to respond to any new rationales for rejection.

#### Claim 19

Claim 19 calls for content-rendering hardware that has an “interface onto which a portable memory is mountable, said interface having a first feature that makes said interface incompatible with portable memories that are readable by devices built in accordance with an open standard.” The Examiner has rejected this claim as being anticipated by Nagano. However, Nagano (particularly the cited portions) to describe a system in which a CD must store a particular type of identifier in order to be used with a certain type of cartridge device. However, there is nothing that makes the CD “incompatible” with memories that are readable by open-standard devices. A CD is still a CD, and is mountable on an ordinary CD player whether or not such CD contains a particular identifier. A particular CD player can be

configured not to play a CD that lacks a specified identifier, but – since such CDs are still mountable on ordinary CD players – there is no interface having a “feature that makes said interface incompatible with portable memories that are readable by devices built in accordance with an open standard.” In short, Nagano does not disclose an interface having the claimed feature. Any unusability of a CD that is described in Nagano is achieved by use of an identifier in the CD, and not by way of the claimed interface.

Accordingly, applicant requests that the rejection of claim 19 be reconsidered.

#### Claim 30

The Examiner has rejected claim 30 as being anticipated by both Olarig and Nagano. However, the Examiner has not addressed how either reference teaches the feature of “determining that an entity is trustworthy to make a portable memory reading or recording device that does not violate rules governing usage of content.” In particular, there is no discussion of how the prior art teaches that an entity is determined to be trustworthy to make a device that meets the features recited in the quoted portion.

Thus, applicant requests that the rejection of claim 30 be reconsidered and withdrawn.

#### Claim 37

Claim 37 has been rejected under section 102(b) as being anticipated by Nagano. Claim 37 calls for rules that are “globally-applicable to a class of content and are not provided in the form of an electronic license.” While the Examiner discusses the “globally-applicable” feature in paragraph 18 of the Office Action, it is unclear what, in Nagano, is asserted to be globally-applicable. It appears from the wording of paragraph 18 that the Examiner has found that Nagano teaches a “globally-applicable” class of devices. It is not clear what it means for a class of devices to be “globally-applicable,” but, in any event, this is not what claim 37 says. To clarify: Claim 30 (on which claim 37 is dependent) calls for “rules governing usage of content,” and claim 37 limits the aforesaid “rules” to those that are “globally-applicable to a class of content” and that are “not provided in the form of an electronic license.” In other words, claim 37 covers: (1) rules that are (2) not provided in the form of an electronic license, and that are (3) globally applicable to a class of content. The Examiner has not addressed any of (1), (2), or (3). If the Examiner continues to believe that



Nagano motivates a modification to recite these features that are set forth in claim 37, it is requested that the Examiner explain, in a subsequent non-final office action, how Nagano can be modified to meet these features.

Moreover, while the Examiner has asserted in paragraph 8 that claim 37 is anticipated by Olarig, the Examiner has not addressed in that paragraph any feature that is found in claim 37. Thus, applicant requests that the Examiner either withdraw the rejection of claim 37 over Olarig, or explain (in a non-final office action, so that applicant can have a meaningful opportunity to respond) what features of Olarig the Examiner believe to teach or suggest claim 37.

For the foregoing reasons, applicant respectfully requests reconsideration of the rejection of claim 37.

#### Claims 31 and 36

As discussed above, the Examiner has rejected claims 31 and 36 over Nagano, and applicant has requested reconsideration of that rejection on the ground that the rejection does not address any of the features that are recited in these claims. However, applicant would like to focus the Examiner's attention particularly on two features in these claims: the "physically incompatible" feature (claim 31); and the feature that rules governing content are "in the form of an electronic license" (claim 36). Although applicant maintains that all of the pending claims have novel and non-obvious features, applicant respectfully submit that, at a minimum, these features define over the applied prior art.

#### Claim 39

Claim 39 has been rejected as being anticipated by Nagano. In explaining this rejection, the Examiner addresses only the last element ("rights management means") (see paragraph 12 of the Office Action), and has not addressed the other features. In particular, the Examiner has not addressed the feature of "mounting means including at least one feature that makes portable memories readable by devices built in accordance with an open standard incompatible with said portable memory recording means."

Applicant thus requests reconsideration of the rejection of claim 39. If the Examiner determines to maintain the rejection of claim 39 for reasons not stated in paragraph 12 of the

Office Action, then applicant requests that the Examiner provide such additional reasons in the form of a non-final Office Action so that applicant can have a meaningful opportunity to respond to such new grounds.

Section 103 rejection of claims 21-23, 27-29, and 32-34

Claims 21-23, 27-29, 32-34: These are specific physical features relating to a portable memory. The Examiner asserts that these features are not taught in Nagano, and has generally referred to "game cartridges used for Atari, Sega, Sony, and Nintendo consoles since their existence." If the Examiner is proposing to combine Nagano with some alleged prior art from Atari, Sega, Sony, and Nintendo, then applicant requests that the Examiner identify this prior art, since it is only vaguely described in the Office Action. Applicant cannot respond to a rejection based on the features of an unidentified game-console product. The manufacturers listed have distributed various different types of game consoles. Applicant is entitled to know what prior art is being applied. If the Examiner believes that a product from one of these manufacturers meets the limitations of the above-mentioned claims, then applicant requests that the Examiner identify the product and the features thereof that are believed to meet the claims, so that applicant can evaluate the position. Applicant cannot compare a claim to a piece of prior art that has not been identified.

Applicant thus request that the rejection of claims 21-23, 27-29, and 32-34 be reconsidered and withdrawn.


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**PATENT**

**Conclusion**

For the reasons set forth above, claims 1-23, and 25-39 have been shown to be patentable over the applied prior art, with claim 24 being patentable at least by reason of its dependency. Applicant submits that the case is in condition for allowance, and requests favorable action on the merits.

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